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USSN 08/100,019

REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

Amendments have been made to claims 1 and 17. A clean copy of claims 1 and 17 is presented above. A mark-up showing the changes that have been made to claims 1 and 17 using brackets and underlining is attached.

Claims 1 and 17 have been amended to provide that the sealed package of film is "outside of a camera." This language is supported by the original specification, for example, in the last paragraph on page 2, where it is taught that the invention provides "a sealed package of film to be opened, put into a camera and exposed." As the specification teaches that the sealed package is to be opened and put into a camera, the specification clearly conveys the concept that the sealed package prior to opening may exist outside of a camera. Although the specification nowhere uses the exact words "outside of a camera," this concept clearly is conveyed by the specification, as explained above, and, therefore, the use of the words "outside of the camera" does not introduce new matter. *See, e.g., In re Anderson*, 176 USPQ 331, 336 (CCPA 1973), for the proposition that in determining whether an amendment to a claim constitutes new matter, the question is not whether the added words are words that are used in the application as filed, but whether the concept embodied by the added words is present in the original specification.

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Claims 7 and 15 were rejected under 35 USC § 112, first paragraph, as being broader than the enabling disclosure. In response, Applicant has canceled claims 7 and 15. Applicant reserves the right to direct a divisional application to the subject matter thereof.

Claims 1-3, 6 and 8 were rejected under 35 USC § 102(b) as being anticipated by Guez, U.S. Patent No. 4,827,291. The details of the rejection were incorporated by reference from the previous Office Action and the Decision of the Board of Appeals affirming the rejection as set forth in the previous Office Action.

In response, Applicant submits that the Decision of the Board of Appeals merits careful attention. According to the Board of Appeals, previous claim 1 was not “limited to films sealed only in a bag or similar containers,” and did “not preclude a partially exposed photographic film sealed in other enclosures, such as a camera itself.” See the Decision of the Board of Appeals in the last full paragraph on page 9.

The Board of Appeals accepted the Examiner’s argument that the previous product claims did not “require that the film be packaged and sealed between exposures.” See the Decision of the Board of Appeals in the paragraph bridging pages 11-12, the remainder of page 12, and the paragraph bridging pages 12-13. According to the Board of Appeals:

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"[Guez] teaches a method of making superimposed pictures on a roll of film by first shooting all the backgrounds (or foregrounds) and rewinding the film in the sealed film compartment of a camera. Next, the foregrounds (or backgrounds) corresponding to each pre-exposed frame are shot on the same film (col. 10, lines 36-46). * *

* We note that the roll of film *remains in the sealed film compartment of the camera* as it is advanced and rewound between the film canister and the right-hand spool. Therefore, before the second exposures are shot, the roll of film is in a sealed package and includes a plurality of exposable photographic frames that are partially exposed leaving exposed and unexposed portions on each frame. Hence, Guez meets the broadly recited "sealed package" of film comprising a plurality of frames having exposed and unexposed portions. [Underlining in original and italics added.]"

In response, Applicant points out that the claims now require, as indicated above, that the sealed package of film exists "outside of a camera." Applicant submits that the claims as amended clearly distinguish over Guez. Because the claimed film is partially pre-exposed, and is contained in a sealed package that exists "outside of a camera," the claimed film must have been packaged and sealed between exposures. Since the Board found that Guez's film "remains in the sealed film compartment of the camera," Guez does not teach a sealed package of film that exists "outside of a camera" or which, therefore, has been packaged and sealed between exposures.

In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and

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withdrawn is earnestly solicited.

Claims 4 and 5 were rejected under 35 USC § 103(a) as being obvious over Guez in view of Jones, U.S. Patent No. 4,304,471. In response, Applicant point out that this rejection was premised on Guez anticipating the basic features of the claimed invention, which, for the reasons given above, is no longer the case. Jones does not teach or suggest packaging and sealing of the film between exposures. Indeed, Jones is relied upon only to teach instant developing film. Accordingly, the combination of Guez and Jones, even if proper, would not have led to an instant developing film that was packaged and sealed between exposures.

Further, Applicant does not believe that the rejection is proper, in spite of the fact it was affirmed by the Board of Appeals. The theory underlying Guez as a technical anticipation was that Guez's film remained in the camera between the first and second exposures, and, therefore, was technically packaged and sealed during the entire process. Of course, in the case of instant developing film, these are ordinarily ejected from the camera. Consequently, it would not have been possible to maintain the film in a packaged and sealed state between exposures.

In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is also earnestly solicited.

Claims 1, 3-6, 8, 11-14 and 17 were rejected under 35 USC § 102(b) as being anticipated by Spector, U.S. Patent No. 4,994,832 ("Spector '832"). In response, Applicant would remind

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the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, if the Examiner relies on a theory of inherency as to any particular element, then the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the reference, and the presence of such element therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, inherency is not established by *probabilities or possibilities*, and the mere fact that a property may result from a given circumstances is not sufficient; instead it must be shown that such property *necessarily* inheres in the thing described in the reference. *Id.*

The Examiner states at the top of page 7 of the Office Action that “Spector ‘832 teaches a package of photographic film,” referring to the reference at column 3, lines 1-4. However, at that portion of Spector ‘832, there is a teaching only of the *forms* of films that may be used. There is no express teaching there or, for that matter, anywhere else in the reference, of a package of film or of a sealed package of film outside of a camera, as instantly claimed.

Moreover, Applicant submits that a sealed package of film outside of a camera is not inherent in the teachings of Spector ‘832. In order to be inherent in a disclosure, the embodiment must *necessarily* exist in the reference’s teachings. *See, again, Robertson, id.* The fact that the embodiment is *possible* following the reference’s teachings is *insufficient*. Instead, the reference teachings must *necessarily* lead to that embodiment. The teachings of Spector ‘832 do not

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necessarily lead to a sealed package of film outside of a camera, as instantly claimed.

Accordingly, the instant claims are not inherently anticipated by Spector '832.

As should be clear from a consideration of Spector '832 at column 1, lines 26 ff, Spector is at least partially concerned with providing the capability of making double-exposed photographs in the context of disposable cameras. Such cameras have been and are often sold pre-loaded with film. Although Spector '832 teaches at various points that the camera is to be loaded with partially pre-exposed film, there is no teaching that the loading must be done by the end-user, and this is not inherent in Spector's teachings since it is certainly possible that the loading can be done by the manufacturer. If the loading is done by the manufacturer, then a sealed package of photographic film outside of a camera, as instantly claimed, *may never exist*. Once the first exposures are made, the manufacturer could simply roll back the film to the beginning without removing the film from the camera and without packaging and sealing the film between exposures—as taught by Guez.

Considering the quote above from *Robertson*, it should be clear that Spector '832 is not an inherent anticipation of the instant claims. It is not necessarily the case that Spector '832 discloses a sealed package of photographic film outside of a camera, as instantly claimed. The teachings of Spector '832 are fully consistent with a pre-loaded disposable camera containing partially pre-exposed film. Such partially pre-exposed film could have been partially pre-exposed by the manufacturer without removing the film from the camera and without packaging

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and sealing the film between exposures. Consequently, the teachings of Spector '832 do not necessarily require a sealed package of photographic film outside of a camera, as instantly claimed. Therefore, Spector '832 is not an inherent anticipation of the instant claims.

In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is also earnestly solicited.

Claims 1, 3-6, 8, 11-14 and 17 were rejected under 35 USC § 102(b) as being anticipated by Spector, U.S. Patent No. 5,111,224 ("Spector '224"). In response, Applicant submits that Spector '224 is a failure as an anticipation for exactly the same reasons as Spector '832. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is also earnestly solicited.

Claims 2, 10 and 16 were rejected under 35 USC § 103(a) as being obvious over Spector '832 in view of Guez. In response, Applicant point out that this rejection was premised on Spector '832 anticipating the basic features of the claimed invention, which, for the reasons given above, is not the case. Guez is of no help in overcoming the basic defects of Spector '832. Indeed, Guez is relied upon only to teach the provision of a pre-exposed border on the photographic frames. Guez would not have led a person having ordinary skill in the art to

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package and seal the film of Spector '832 outside of a camera if, for no other reason, because the Board of Appeals held that Guez taught the film remained inside of the camera between exposures. Consequently, the combination of Spector '832 and Guez still does not render *prima facie* obvious a sealed package of photographic film outside of a camera, as instantly claimed.

In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is also earnestly solicited.

Claims 2, 10 and 16 were rejected under 35 USC § 103(a) as being obvious over Spector '224 in view of Guez. In response, Applicant submits that the combination of Spector '224 and Guez fails to establish *prima facie* obviousness for exactly the same reasons as the combination of Spector '832 and Guez. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is also earnestly solicited.

Applicant believes that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicant also believes that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to

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telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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By

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 and the attached Mark-Up Showing the Changes Made in the Previous Claims to Yield the Claims as Amended Above and the accompanying Petition for Extension of Time (13 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: March 17, 2003

By:

Kurt G. Briscoe

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**MARK-UP SHOWING THE CHANGES MADE IN THE PREVIOUS CLAIMS TO
YIELD THE CLAIMS AS AMENDED ABOVE**

--1. (Twice Amended) A sealed package of photographic film comprising a plurality of exposable photographic frames to be exposed, each exposable photographic frame comprising a first unexposed portion and a second exposed portion, said sealed package of photographic film being outside of a camera--

-17. (Once Amended) A process for obtaining a developed photograph comprising:

- a) providing a sealed package of photographic film outside of a camera as claimed in claim 1;
- [a]b) opening [a] the sealed package of film [according to claim 1] and removing the film therein;
- [b]c) placing the film into a camera;
- [c]d) exposing a photographic frame of said film while in said camera; and
- [d]e) developing said exposed photographic frame.--